

Remarks

The Office Action mailed July 17, 2006 has been carefully reviewed and the foregoing amendment and following remarks have been made in consequence thereof.

Claims 1-63 are pending in this application. Claims 1-20 and 45-53 stand rejected. Claims 21-44 and 54-63 have been withdrawn from consideration.

In accordance with 37 C.F.R. 1.136(a), a two-month extension of time is submitted herewith to extend the due date of the response to the Office Action dated July 17, 2006, and made final, for the above-identified patent application from October 17, 2006, through and including December 17, 2006. In accordance with 37 C.F.R. 1.17(a)(3), authorization to charge a deposit account in the amount of \$450.00 to cover this extension of time request also is submitted herewith.

The rejection of Claims 1-7, 11-17 and 45-48 under 35 U.S.C. § 103(a) as being unpatentable over King (U.S. Patent No. 6,148,293) is respectfully traversed.

Applicants respectfully submit that King does not describe or suggest the claimed invention. As discussed below, at least one of the differences between the present invention and King is that King does not describe or suggest a method for operating a computer to facilitate a choice of a financing product for financing an energy-related asset that includes prompting a customer to input information describing the energy-related asset for which financing is being sought, wherein the energy-related asset includes at least one of a power generating facility, a refinery, a mine, and a pipeline.

Moreover, King does not describe or suggest prompting the customer to input responses to a plurality of questions regarding requirements for financing the energy-related asset, analyzing the information inputted into the computer by the customer, and recommending to the customer based on the analyzed information a type of financing to be used by the customer for financing the energy-related asset, wherein the financing types include financing project, high yield debt, leasing, project common equity, limited partnership, private equity and preferred equity.

King describes an operatively interconnected data processing and computing system for creating, servicing and paying loan agreements between a lender and borrower, and

providing for repayment of the loan together with interest at a periodically adjusted rate based on the terms of the agreement. The system includes data processing for a novel form of relationship management links, supervising and balancing the interests of contractholders, marketing agents, financial intermediaries, investment managers, investment bankers, custodians, rating agencies and an issuing entity.

More specifically, King describes a computer-based system that employs operatively interconnected data processing and computing means for creating, servicing and paying in financial contracts having terms and conditions which provide repayment of monies tendered by one entity to another on a date or dates in the future, along with periodically provided compensation thereon. The system includes a means for inputting and storing into at least one electronic database, which includes one or more accounts, the negotiated terms and conditions of a financial contract with an identified lender which provides for the level of compensation thereon to be adjusted periodically to produce a rate of compensation tied to an external benchmark, allowing the issuing entity to establish a lower rate of compensation in any period in which its solvency or deteriorating credit quality, including with respect to the business activity to which the contract relates, is otherwise threatened in exchange for establishment of a higher rate of compensation during periods in which the results of a formula computation exceed certain pre-agreed levels. The system further includes a means accessible to at least one electronic database for issuing and displaying the financial contract and terms thereof with constraints comprising the agreed terms and conditions.

Claim 1 recites a method for operating a computer to facilitate a choice of a financing product for financing an energy-related asset, the method includes "prompting a customer to input into the computer information describing the energy-related asset for which financing is being sought, wherein the energy-related asset including at least one of a power generating facility, a refinery, a mine, and a pipeline...prompting the customer to input into the computer responses to a plurality of questions regarding requirements for financing the energy-related asset...analyzing the information inputted into the computer by the customer...and recommending to the customer based on the analyzed information a type of financing to be used by the customer for financing the energy-related asset, wherein the financing types include financing project, high yield debt, leasing, project common equity, limited partnership, private equity and preferred equity."

King does not describe or suggest a method for operating a computer to facilitate a choice of a financing product for financing an energy-related asset as recited in Claim 1. More specifically, King does not describe or suggest a method that includes prompting a customer to input into the computer information describing the energy-related asset for which financing is being sought, wherein the energy-related asset includes at least one of a power generating facility, a refinery, a mine, and a pipeline.

Moreover, King does not describe or suggest prompting the customer to input into the computer responses to a plurality of questions regarding requirements for financing the energy-related asset, analyzing the information inputted into the computer by the customer, and recommending to the customer based on the analyzed information a type of financing to be used by the customer for financing the energy-related asset, wherein the financing types include financing project, high yield debt, leasing, project common equity, limited partnership, private equity and preferred equity.

Rather, King describes an operatively interconnected data processing and computing system for creating, servicing and paying loan agreements between a lender and borrower, and providing for repayment of the loan together with interest at a periodically adjusted rate based on the terms of the agreement. King does not describe or suggest a method for operating a computer to facilitate a choice of a financing product for financing an energy-related asset as recited in Claim 1. More specifically, King does not describe or suggest a method that includes prompting a customer to input into the computer information describing the energy-related asset for which financing is being sought wherein the energy-related asset includes at least one of a power generating facility, a refinery, a mine, and a pipeline, nor does King describe or suggest recommending to a customer based on the analyzed information a type of financing to be used by the customer for financing the energy-related asset, wherein the financing types include financing project, high yield debt, leasing, project common equity, limited partnership, private equity and preferred equity. Accordingly, for at least this reason, Applicants respectfully submit that Claim 1 is patentable over King.

For at least the reasons set forth above, Applicants respectfully request that the 35 U.S.C. § 103(a) rejection of Claim 1 be withdrawn.

Claims 2-7 depend from independent Claim 1 which is submitted to be in condition for allowance. When the recitations of Claims 2-7 are considered in combination with the

recitations of Claim 1, Applicants submit that dependent Claims 2-7 are also patentable over King.

Claim 11 recites a computer for facilitating a selection of a financing product for financing an energy-related asset, the computer programmed to “prompt a customer to provide information related to a financing requirement...prompt a customer to input information describing the energy-related asset for which financing is being sought, wherein the energy-related asset including at least one of a power generating facility, a refinery, a mine, and a pipeline...prompt the customer to input responses to a plurality of questions regarding requirements for financing the energy-related asset...analyze the information inputted by the customer...and recommend to the customer based on the analyzed information a type of financing to be used by the customer for financing the energy-related asset, wherein the financing types include financing project, high yield debt, leasing, project common equity, limited partnership, private equity and preferred equity.”

Claim 11, as herein amended, recites a computer for facilitating a selection of a financing product for financing an energy-related asset that is programmed to perform steps essentially similar to those recited in Claim 1. Thus, it is submitted that Claim 11 is patentable over King for reasons that correspond to those given with respect to Claim 1.

For at least the reasons set forth above, Claim 11 is submitted to be patentable over King.

Claims 12-17 depend from independent Claim 11 which is submitted to be in condition for allowance. When the recitations of Claims 12-17 are considered in combination with the recitations of Claim 11, Applicants submit that dependent Claims 12-17 are also patentable over King.

Claim 45 recites an apparatus for facilitating a selection of a financing product for financing an energy-related asset, the apparatus including “means for prompting a customer to input information describing the energy-related asset for which financing is being sought, wherein the energy-related asset including at least one of a power generating facility, a refinery, a mine, and a pipeline...means for prompting the customer to input responses to a plurality of questions regarding requirements for financing the energy-related asset...means for analyzing the information inputted into the computer by the customer...and means for

recommending to the customer based on the analyzed information a type of financing to be used by the customer for financing the energy-related asset, wherein the financing types include financing project, high yield debt, leasing, project common equity, limited partnership, private equity and preferred equity.”

Claim 45, as herein amended, recites an apparatus for facilitating a selection of a financing product for financing an energy-related asset that includes a means for performing steps essentially similar to those recited in Claim 1. Thus, it is submitted that Claim 45 is patentable over King for reasons that correspond to those given with respect to Claim 1.

For at least the reasons set forth above, Claim 45 is submitted to be patentable over King.

Claims 46-48 depend from independent Claim 45 which is submitted to be in condition for allowance. When the recitations of Claims 46-48 are considered in combination with the recitations of Claim 45, Applicants submit that dependent Claims 46-48 are also patentable over King.

For at least the reasons set forth above, Applicants respectfully request that the Section 103 rejection of Claims 1-7, 11-17 and 45-48 be withdrawn.

The rejection of Claims 8-10, 18-20, and 51-53 as being unpatentable over King in view of Walters et al. (U.S. Patent Application 2002/0143680) (hereinafter referred to as “Walters”) is respectfully traversed.

King is described above. Walters describes a computer system for assisting financial professionals in determining appropriate financial products for clients, wherein the system includes a computer readable memory storing a computer program executable by a processor and including a client questionnaire module that presents a first set of questions to a client and receives a first set of answers. The questionnaire module also presents subsequent sets of questions to the client which are customized based on the answers to the first and other previous sets of questions so that the client is not asked redundant, unnecessary, or inappropriate questions. The questionnaire module also receives answers to the subsequent sets of questions that request personal information comprising client and dependent names, ages, and marital status; financial information on one or more of savings accounts, investment accounts, insurance policies, retirement accounts, stock options, trusts, history of

gifts to family members, loans, charitable contributions, charitable trusts, property, businesses, and income sources; and goal information including retirement age and income goals and estate related goals. A financial product module stores information regarding each financial product available for sale by the financial professional. The financial products include one or more of insurance products, investment products, estate planning products, and business products. An expert system module including a stored set of rules can be applied to the answers to the first and subsequent sets of questions for determining which if any of the available financial products are appropriate to the client's financial situation and goals; one or more illustration modules which calculate the financial results of executing the financial products appropriate to the client's financial situation and goals; a financial professional interface module for generating a web page displaying the client's current personal and financial status and the suitability of one or more of the available financial products for the client's financial situation and goals; and a client interface module for generating a web page displaying one or more of the client's current marketable securities values, income goals, estimated retirement income, estate tax projections, and net proceeds to heirs.

Claims 8-10 depend, directly or indirectly, from independent Claim 1, which is recited above. As discussed above, King does not describe or suggest a method for operating a computer to facilitate a choice of a financing product for financing an energy-related asset as recited in Claim 1. Walters does not make up for the deficiencies of King. Because neither King nor Walters describes or teaches one or more of the claimed elements of Claim 1, it follows that a combination of King and Walters cannot describe or teach such elements. Accordingly, for at least the reasons set forth above, Applicants respectfully submit that Claim 1 is patentable over King in view of Walters.

When the recitations of Claims 8-10 are considered in combination with the recitations of Claim 1, Applicants respectfully submit that dependent Claims 8-10 likewise are patentable over King in view of Walters.

Claims 18-20 depend, directly or indirectly, from independent Claim 11, which is recited above. As discussed above, King does not describe or suggest a computer for facilitating a selection of a financing product for financing an energy-related asset as recited in Claim 11. Walters does not make up for the deficiencies of King. Because neither King nor Walters describes or teaches one or more of the claimed elements of Claim 11, it follows

that a combination of King and Walters cannot describe or teach such elements. Accordingly, for at least the reasons set forth above, Applicants respectfully submit that Claim 11 is patentable over King in view of Walters.

When the recitations of Claims 18-20 are considered in combination with the recitations of Claim 11, Applicants respectfully submit that dependent Claims 18-20 likewise are patentable over King in view of Walters.

Claims 51-53 depend, directly or indirectly, from independent Claim 45, which is recited above. As discussed above, King does not describe or suggest an apparatus for facilitating a selection of a financing product for financing an energy-related asset as recited in Claim 45. Walters does not make up for the deficiencies of King. Because neither King nor Walters describes or teaches one or more of the claimed elements of Claim 45, it follows that a combination of King and Walters cannot describe or teach such elements. Accordingly, for at least the reasons set forth above, Applicants respectfully submit that Claim 45 is patentable over King in view of Walters.

When the recitations of Claims 51-53 are considered in combination with the recitations of Claim 45, Applicants respectfully submit that dependent Claims 51-53 likewise are patentable over King in view of Walters.

Moreover, Applicants respectfully submit that the Section 103 rejection of the presently pending claims is not a proper rejection. As is well established, obviousness cannot be established by combining the teachings of the cited art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination. Neither King nor Walters, considered alone or in combination, describe or suggest the claimed combination. Furthermore, in contrast to the assertion within the Office Action, Applicants respectfully submit that it would not be obvious to one skilled in the art to combine King with Walters because there is no motivation to combine the references suggested in the art. Additionally, the Examiner has not pointed to any prior art that teaches or suggests to combine the disclosures, other than Applicants' own teaching.

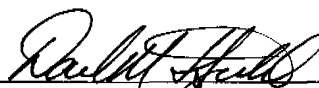
As the Federal Circuit has recognized, obviousness is not established merely by combining references having different individual elements of pending claims. Ex parte Levengood, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993). MPEP 2143.01. Rather,

there must be some suggestion, outside of Applicants' disclosure, in the prior art to combine such references, and a reasonable expectation of success must be both found in the prior art, and not based on Applicant's disclosure. In re Vaeck, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). In the present case, neither a suggestion or motivation to combine the prior art disclosures, nor any reasonable expectation of success has been shown.

Furthermore, it is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the cited art so that the claimed invention is rendered obvious. Specifically, one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the art to deprecate the claimed invention. Further, it is impermissible to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. The present Section 103 rejection is based on a combination of teachings selected in an attempt to arrive at the claimed invention. Since there is no teaching nor suggestion in the cited art for the combination, the Section 103 rejection appears to be based on a hindsight reconstruction in which isolated disclosures have been picked and chosen in an attempt to deprecate the present invention. Of course, such a combination is impermissible, and for these reasons, along with the reasons given above, Applicants request that the Section 103 rejections of Claims 8-10, 18-20, and 51-53 be withdrawn.

In view of the foregoing amendments and remarks, all the claims now active in this application are believed to be in condition for allowance. Favorable action is respectfully solicited.

Respectfully submitted,



Daniel M. Fitzgerald
Registration No. 38,880
ARMSTRONG TEASDALE LLP
One Metropolitan Square, Suite 2600
St. Louis, Missouri 63102-2740
(314) 621-5070